

Withdrawal of Final Rejection

Applicant respectfully requests the Examiner to withdraw the Final Rejection pursuant to MPEP §706.07(e), based on the following showing under 37 C.F.R. §1.116(b) or in the alternative, as premature.

In the Final Office Action, mailed August 4, 1994, the Examiner stated in paragraph 4 (top of page 4) that Claims 1-20 and 23 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §112. The rejections of Claims 1-20 and 23 were all based on 35 U.S.C. §112, second paragraph. Applicant filed an amendment addressing these rejections on November 3, 1994.

However, during the Examiner Interview, the Examiner stated new grounds of rejection based on 35 U.S.C. §112, first paragraph. Thus, the present amendment is necessary to address the Examiner's new ground of rejection and could not have been presented earlier because the Examiner did not provide this new ground of rejection until the Examiner Interview.

Moreover, MPEP § 706.07 entitled "Final Rejection" states:

"Before final rejection is in order a clear issue should be developed between the Examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in response to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection."

Here, Applicant respectfully submits the final rejection is premature. The Applicant responded to the 35 U.S.C. § 112, second paragraph rejection by amending the claims in good faith only to have the Examiner then assert a 35 U.S.C. 112, first paragraph rejection against the Applicant. Applicant respectfully submits that in accordance with the spirit and language of § 706.07 of the MPEP, the Examiner should have recognized both of these alleged indefinitenesses in the

LAW OFFICES OF  
SKJERVEN, MORRILL,  
MCMILLAN, FRANKLIN  
& FRIEL

25 METRO DRIVE  
SUITE 702  
SAN JOSE, CA 95110  
(408) 283-1222  
FAX (408) 283-1233

L:\DMS\9885\M-2689\_U\0111899.01

initial review of the Amendment filed May 4, 1994, and required correction under both 35 U.S.C. 112, first paragraph and second paragraph in the same Office Action. Applicant believes that the final rejection therefore is premature and should be withdrawn at this time. Applicant in good faith amended the claims to overcome the 35 U.S.C. 112, second paragraph rejection and believed, in view of the Examiner's comment in paragraph 4 of the Final Office Action that "Claims 1-20 and 23 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112." This Applicant has done. For the Examiner now to allege a different 35 U.S.C. 112, indefiniteness rejection and not to withdraw the final rejection Applicant believes is premature. If the Examiner does not withdraw the final rejection Applicant will have no choice but to petition to the Commissioner for redress.

#### Objection to the Drawings

Applicant notes the Examiner's objections and will correct the discrepancies in the Formal drawings.

#### Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 1-23 are rejected under 35 U.S.C. §112, second paragraph for indefiniteness. The Examiner has cited specific language in Claims 1, 14, 16 and 23 as indefinite. Claims 1, 14, 16 and 23 are amended to be more definite. Specifically, Claim 1 is amended to recite in pertinent part:

power control means for supplying a variable voltage to said memory integrated circuit without varying a voltage being supplied to elements of said electronic system other than said memory integrated circuit (emphasis added)

The phrase "the portions" is replaced with --elements--, and the phrase "independently from the" was replaced with --without varying a--.

This new language is fully supported in the specification

LAW OFFICES OF  
SHERVEN, MORRILL,  
MACPHERSON, FRANKLIN  
& FRIEL

25 METRO DRIVE  
SUITE 700  
SAN JOSE, CA 95110  
(408) 283-1222  
FAX (408) 283-1223

L:\DMS\9885\1M-2689\_U\0111899.01

Claim 23

## Conclusion

LAW OFFICES OF  
SKIERNEN, MORRILL,  
McPHERSON, FRANKLIN  
& FRIEL.

25 METRO DRIVE  
SUITE 700  
SAN JOSE, CA 95110  
(408) 283-1222  
FAX (408) 281-1331

If the Examiner's next action is other than allowance of Claims 1-20 and 23, the Examiner is respectfully requested to call Applicant's attorney at (408) 283-1222.

Respectfully submitted,



Alan H. MacPherson  
Attorney for Applicants  
Reg. No. 24,423

Certification of Facsimile Transmission

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Lawrence E. Lycke

Type or print name of person signing certification

Lawrence E. Lycke

Signature

12/5/94

Date